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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,640

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EXAMINER

STULTZ, JESSICA T

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,640	<b>Applicant(s)</b> ESSER ET AL.	
	<b>Examiner</b> JESSICA T. STULTZ	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>090506</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 17 is objected to because of the following informalities: the term "astimagnetic" should be "astigmatic". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-16, 22-25 (and thereby dependent claims 17-21 and 26-28) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically regarding independent claim 14, the phrase "wherein the rear face...is constructed substantially from cosmetic viewpoints without consideration of optical image-forming properties" is vague and indefinite since it is not clear is the intended limitation of the claim. Specifically it is not clear what limitation the phrase "constructed substantially from cosmetic viewpoints" places on the claim. In the specification it is mentioned that cosmetic properties include edge thickness, edge variation, center thickness, and the weight or volume of the lens. However, it is not claimed if the rim region is designed by taking into account these properties, fulfills certain requirements of these properties, if the rim portion is designed by a manufacturer located at a cosmetic viewpoint, or some other meaning entirely. For purposes of examination, the assumed meaning is "wherein the rear face in the carrier rim region is constructed substantially based on desired cosmetic properties, without consideration of optical image-forming properties".

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Specifically regarding independent claim 23, the phrase “optimization of the rear face...carried out essentially from cosmetic viewpoints without considering the optical image-forming properties of the carrier rim region” is vague and indefinite since it is not clear is the intended limitation of the claim. Specifically it is not clear what limitation the phrase “constructed substantially from cosmetic viewpoints” places on the claim. Additionally it is not clear if the phrase “optical image-forming properties of the carrier rim region” means that the carrier rim region has image-forming properties (which is not supported by the drawings and specification or lines 4-5 which state that the rim region does not contribute to the optical effect of the lens). In the specification it is mentioned that cosmetic properties include edge thickness, edge variation, center thickness, and the weight or volume of the lens. However, it is not claimed if the rim region is designed by taking into account these properties or to fulfill certain requirements of these properties. For purposes of examination, the assumed meaning is “optimization of the rear face in the carrier rim region, the calculation and/or optimization being carried out essentially based on desired cosmetic properties, without considering optical image-forming properties”.

Regarding claims 15-16 and 24-25, the phrase “outermost peripheral rays to the rear face” is vague and indefinite since it is not clear how the rays can be “peripheral” and also not pass through the “peripheral” zone. For purposes of examination the assumed meaning is “outermost viewable peripheral rays”.

Regarding claim 22, the phrase “reduce volume and mass of the spectacle lens” is vague and indefinite since it is not clear if the region is designed to reduce volume and mass of the lens

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blank, the entire lens or some other meaning entirely. For purposes of examination the assumed meaning is "reduce volume and mass of the entire spectacle lens".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Guilino US 4,784,482, herein referred to as Guilino '482.

Regarding claim 14, Guilino '482 discloses a spectacle lens (Abstract, Figure 1-2) having object-sided front face (Figure 1) and an eye- sided rear face (4) that comprises a viewing region (focal section 1) which contributes to the optical effect of the spectacle lens (Column 3, lines 24-48 and Column 4, lines 33-54, wherein the viewing region 1 comprises regions N, F, Z that effect the optical power of the lens, Figures 1-2), and a carrier rim region (3) which surrounds at least partially the viewing region and which does not significantly contribute to the optical effect of the spectacle lens (Column 3, lines 18-23 and Column 4, lines 33-54), wherein the rear face in the carrier rim region is constructed substantially based on desired cosmetic properties, without consideration of optical image-forming properties (Column 4, lines 33-54, wherein the thickness of the rim zone 3 is uniform and does not have optical image-forming properties, Figures 1-2).

Regarding claim 15, it is inherent from Guilino '482 further discloses that the viewing region (1) is separated from the carrier rim region (3) on the rear face of the spectacle lens by a dividing curve (Figures 1-2) that connects penetrating points of outermost viewable peripheral

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rays to the rear face, said outermost viewable peripheral rays just barely passing, under direct vision, through a point of rotation of the eye when the spectacle lens is in a use position in front of an eye (Column 3, lines the disclosure of the focal region 1 located interiorly of the rim zone 3, which would mean that the zones are divided by a line separating the viewable rays from the non-viewable peripheral rays).

Regarding claim 16, it is inherent from Guilino '482 further discloses that the viewing region (1) is separated from the carrier rim region (3) on the rear face of the spectacle lens by a dividing curve (Figures 1-2) that connects the penetrating points of outermost viewable peripheral rays to the rear face, and said outermost viewable peripheral rays just barely pass, under indirect vision, through the center of the entrance pupil of the eye (Column 3, lines the disclosure of the focal region 1 located interiorly of the rim zone 3, which would mean that the zones are divided by a line separating the viewable rays, i.e. that pass through the entrance pupil of the eye, from the non-viewable peripheral rays).

Regarding claim 17, Guilino '482 further discloses that the spectacle lens exhibits at least one of a positive, negative, progressive, astigmatic and prismatic optical power (Column 3, lines 24-48 and Column 4, lines 25-32).

Regarding claim 18, Guilino '482 further discloses that the rear face in the carrier rim region is constructed to consider at least one of a frame shape and a frame design (Column 3, lines 18-23, wherein the rim zone 3 is constructed to have constant thickness and would inherently be placed in a desired frame).

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Regarding claim 19, Guilino '482 further discloses that the rear face in the carrier rim region is constructed to consider individual parameters of the spectacle wearer (Column 4, lines 11-54, wherein surfaces are optimized to be designed as desired by the user).

Regarding claim 20, Guilino '482 further discloses that the rear face is designed so that the rear face of the carrier rim region is joined in at least once, preferably in a twice continuously, differentiable manner to the rear face in the viewing region (Column 3, lines 24-48, Shown in Figures 1-2).

Regarding claim 21, Guilino '482 further discloses that the rear face in the carrier rim region is constructed to reduce at least one of an edge thickness, edge thickness variation and center thickness of the spectacle lens (Column 3, lines 18-23, wherein the rim zone 3 is constructed to have constant thickness, Figures 1-2).

Regarding claim 22, Guilino '482 further discloses that the rear face in the carrier rim region is configured to reduce volume and mass of the entire spectacle lens (Column 3, lines 18-23, wherein the rim zone 3 is constructed to have constant thickness thinner than the rest of the lens which would inherently reduce the volume/mass of the lens, Figures 1-2).

Regarding claim 23, Guilino '482 discloses a method for producing a spectacle lens (Abstract, Figures 1-2) with an object-sided front face (Figure 1) and an eye-sided rear face (4) having a viewing region that contributes to the optical effect of the spectacle lens (Column 3, lines 24-48 and Column 4, lines 33-54, wherein the viewing region 1 comprises regions N, F, Z that effect the optical power of the lens, Figures 1-2), and a carrier rim region (3) that at least partially surrounds the viewing region and does not significantly contribute to the optical effect of the spectacle lens (Column 3, lines 18-23 and Column 4, lines 33-54), comprising carrying out

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at least one of a calculation and optimization of the rear face in the carrier rim region carried out essentially from cosmetic viewpoints without considering the optical image-forming properties (Column 4, lines 11-54, wherein the thickness of the rim zone 3 is calculated and optimized to be uniform and does not have optical image-forming properties, Figures 1-2).

Regarding claim 24, it is inherent from Guilino '482 further discloses that the at least one of calculation and optimization comprises calculation of a dividing curve (Figures 1-2) on the rear face (4) between the viewing region (1) and the carrier rim region (3) in a curve shape that connects penetrating points of outermost viewable peripheral rays to the rear face, said outermost viewable peripheral rays just barely passing, under direct vision, through a point of rotation of the eye when the spectacle lens is in a use position in front of the eye of a spectacle wearer (Column 3, lines the disclosure of the focal region 1 located interiorly of the rim zone 3, which would mean that the zones are divided by a line separating the viewable rays from the non-viewable peripheral rays).

Regarding claim 25, it is inherent from Guilino '482 further that the viewing region is separated from the carrier rim region on the rear face of the spectacle lens by a dividing curve (Figures 1-2) that connects the penetrating points of outermost viewable peripheral rays to the rear face, and said outermost viewable peripheral rays just barely pass, under indirect vision, through the center of the entrance pupil of the eye (Column 3, lines the disclosure of the focal region 1 located interiorly of the rim zone 3, which would mean that the zones are divided by a line separating the viewable rays from the non-viewable peripheral rays).

Regarding claim 26, Guilino '482 further discloses that at least one of calculation and optimization takes place so that at least one of the frame shape and design is taken into



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consideration (Column 3, lines 18-23, wherein the rim zone 3 is constructed to have constant thickness and would inherently be placed in a desired frame).

Regarding claim 27, Guilino '482 further discloses at least one calculation and optimization takes place so that the individual parameters of the spectacle wearer are taken into consideration (Column 4, lines 11-54, wherein surfaces are optimized to be designed as desired by the user).

Regarding claim 28, Guilino '482 further discloses that at least one calculation and optimization takes place so that the rear face in the carrier rim region is joined in a at least once, preferably in a twice, continuously, differentiable manner to the rear face in the viewing segment (Column 3, lines 24-48, Shown in Figures 1-2).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bettiol et al US 4,279,480, Miller US 5,608,471, Kato US 6,199,983, Gotou US 7,147,325, Mandler US 7,413,502, and Poesch US 7,338,340 are cited since they disclose ophthalmic lenses including non-optical rim peripheral portions that are constructed without consideration of optical image-forming properties and would at least read on independent claim 14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA T. STULTZ whose telephone number is (571)272-2339. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica T Stultz  
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